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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,791	05/09/2001	Hiroshi Kutsumi	MTS-3257US	3296

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,791

Applicant(s)

KUTSUMI ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,28 and 45-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,6,28 and 45-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended claims 5, 28, and newly added claims 45-52. All pending claims (5, 6, 28, and 45-52) were examined in this final office action necessitated by amendment.

Response to Arguments

Foreign Priority

Applicant's filing of a certified copy of the foreign application is noted.

Objections to the Specification

The Applicant amended the abstract: Objection to the specification is withdrawn.

Rejection under 35 USC 102

Applicant's arguments, see Remarks, filed 24 January 2005, with respect to the rejection(s) of claim(s) 5, 6, 28, and 45-52 under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Whiteis under 35 USC 103 as necessitated by amendment. Whiteis teaches making recommendations based on actual user interest experience, recommending items unknown to the user linked to items of known interest to the

user, and further teaches recommendations being based on how often linked items appear on lists.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 5, 6, 28, and 45-52 are rejected under 35 USC 103(a) as being unpatentable over Whiteis (Paper #20041004, US 5,749,081), in view of Official Notice (regarding well within the skill).**

Whiteis teaches a system and method for assisting a consumer in selecting items from a master list of available items and recommending items from the master list based on the input list of favored items, the recommended items having a high probability of appeal to the consumer. Whiteis teaches each use by the consumer increases the accuracy of the system (see at least abstract; Fig. 1 (1, 2, 3); col. 1, lines 64 through col. 2, line 36). Whiteis further teaches:

- Recommended contents are output by output means: sort and display results; update "links" table, update "linksto" table (see at least Fig. 1 (3); col. 5, line 25 through col. 6, line 44).

- Checking access history of the user: checks items previously sampled by the user (see at least col. 1, line 64 through col. 2, line 15).
- Number of registration times: based on number of times items appeared linked together (item currently or previously sampled) (see at least col. 2, lines 8-15; col. 3, lines 19-23); numerical value created by the summing the link weights for each of the matches (see at least Fig. 9 (351); col. 3, line 24 through col. 4, line 27; col. 3, lines 52-55).
- Content registration: content exists and is searched as noted above (please note examiner's interpretation: content is registered).

Whiteis teaches all the above as noted under the 103(a) rejection and further teaches a) a system and method of recommending items known to a user linked to items not known to the user, and b) making recommendations to a user based on items in a list of possible selections (please note examiner's interpretation: information extracted for recommendation) that the user has already indicated an interest in and saving such information (please note examiner's interpretation: interest indicated in a previous experience), and on other information such as age, gender, economic bracket (see at least col. 1, lines 28-35). It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Whiteis to automate recommendations based on the same user's interest experience, since it is well within the skill to ascertain actual user experience as being relevant to the recommendation process.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', with a stylized flourish at the end.

Robert M. Pond
Primary Examiner
May 9, 2005